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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,096	12/01/2003	Shoichi Tsuboi	9333/358	1761

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EXAMINER

WARREN, DAVID S

ART UNIT	PAPER NUMBER
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2837

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/725,096

Applicant(s)

TSUBOI, SHOICHI

Examiner

David S. Warren

Art Unit

2837

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/01/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1 – 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claims 1 and 16, the Applicant recites a “version” of the “second storing unit.” Does this refer to the version of the software used to process the stored data, the hardware, or updated content?
Regarding claims 1 – 20, these claims refer to storing “information about predetermined storage medium.” Typically, a storage medium defines the material (or type) of storage, e.g., CD, magnetic tape, hard disk, ROM, etc. However, while very confusing, it appears from Applicant’s specification, that “information about storage medium” actually refers to information stored on the medium. These two interpretations are very different.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 – 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 1, it is not understood as to what is meant by “a first storage unit operable to store music information to music data [Emphasis added]. In the §103 rejection that follows, the Examiner interprets this to be “music information on music data.” Or should it be “information and music data”? While these nuances may appear trivial, the Examiner maintains these differences to be extremely significant. Clarification is required. As stated supra, it cannot be understood as to what is meant by “plurality of storage media.” Typically this would mean more than one type of media (e.g., hard disk and CD). However, while very confusing, it appears that the Applicant is intending to mean, e.g., plural CDs. This claim (lines 7 and 8) also states that individual songs are stored in the first storing unit, but in the previous limitation (lines 4 and 5) the second storing unit stores individual songs. Furthermore, it appears that (line 3) only music information (not music data, i.e., song data) is stored in the first storing means. This limitation (lines 6 – 9) refers to the second storing unit as having “information about the storage medium” when the previous limitation (lines 4 – 5) refers only to information about individual songs on a storage medium. Again, while this distinction may appear trivial, it ultimately will define the examination process. Does the second storage unit store information about individual songs or about the storage medium itself? Or both? Also in claim 1, it is not understood as to what is meant by “the version of [the] second storing unit.” As stated supra, this could be interpreted several ways. The Examiner, as best as can be

interpreted from the specification, is interpreting “version” to be data (i.e., music information about individual songs stored in the second storing unit. It should also be noted, that the Examiner is interpreting “music information” as metadata (i.e., song title, artist, album, etc.) and music data as the actual audio data (e.g., MP3, WAV data, etc.). Finally, as best as can be understood, the final clause of claim 1 (lines 14 – 16) appears to be stating that processing takes place “if the music information... stored in said third storing unit is stored in said second storing unit.” As written, it is virtually impossible for the Examiner to tell which types of data (information vs. data) is to be stored in which storing unit and when that data is processed. For the purposes of the rejection which follows, the Examiner is interpreting the claim limitations as merely employing storage units to add information to data when storage contents are updated. Regarding claims 8, 16, and 18, as stated supra, the Applicant refers to “plurality of storage media” and “information about storage medium” – typically, “media” refers to the type of storage device (CD, magnetic tape, hard disk, etc.). However, the Examiner believes the Applicant intends to recite the data content rather than the media itself. Clarification is required. Regarding claims 16 and 18, the phrase “without adding the music information or with adding substituting music information” is confusing. Perhaps written “without adding the music information or with substituting music information” would be clearer. In claim 18, the Applicant claims “first, second and third control units” – the Applicant is requested to confirm that this is not a typographical error (should this be “first, second and third storage units”?). Regarding claims 3 and 10, as best as the Examiner can understand, does the Applicant mean to claim “if the music information is

not stored in said second storing unit"? The Examiner understands the purpose of Applicant's invention to be adding and/or substituting data (from the Internet) if it is not stored locally. But claim 3, recites without adding music information if the information is not stored in storing unit. This is interpreted as "if the data is not local, don't add it." Yet, the crux of the invention appears to be "if the data is not local, add it." This is very confusing. Applicant's claim 9 appears to corroborate the Examiner's assertion. Clarification is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. (6,304,523). Regarding claims 1, 8, 16, and 18, Jones et al. disclose the use of a first storage unit for storing music information (i.e., metadata) and music data (i.e., a CD which stores TOC and digital audio data), a second storing unit for storing data on individual songs (18, col. 6, lines 30 – 33), and a control unit (14) for determining if information on a individual song is stored and obtaining the information from an external database (via the Internet) if the data is not stored (col. 5, lines 60 – 64). Jones does not disclose the use of a third storing unit. However, Jones performs

the same function (i.e., to obtain and update data if it is not stored locally) as that of the Applicant. Therefore, the Examiner maintains that Applicant's use of a third storing unit is functionally equivalent to that of Jones. In other words, Jones provides the same process without the need for a redundant storing unit. It would have been obvious to one of ordinary skill to provide Jones with a third storing unit. The motivation for making this modification would be to offer more processing options (which Applicant is silent as to any advantage as to procession options). Specifically regarding claim 8, the "music information obtaining unit" is shown as elements 22 and 13. Regarding claim 2, the Examiner maintains that the music information is displayed while the song is playing, this is a result of being added and stored together (or functionally equivalent thereof). Regarding claims 3 and 10, as best as can be understood, Jones discloses adding data if it is not found locally. Regarding claims 4 and 12, Official Notice is taken that encoding of CDs is notoriously well-known, i.e., converting WAV files MP3 is standard CD ripping technology. Regarding claims 5 and 13, this claim refers to "partitioning" which is a well-known technique for segmenting a hard disk into plural storing units. Regarding claims 6 and 14, Jones discloses a CD with TOC data (col. 3, lines 33 – 40). Regarding claims 7 and 15, Jones discloses the use of title and track information (col. 5, lines 29 and 30). Official Notice is hereby taken that "album name, artist name and title of the songs" are known in the art as metadata, and it is extremely well-known provide these attributes to a media player. Regarding claims 9, 11, 17, and 19, Jones discloses adding data to storing unit with information found from the Internet if the data is not found locally (col. 5, second paragraph; col. 6, see the paragraph beginning at line 26).

As stated supra, Jones does not explicitly define all storing features and units as claimed by the Applicant. However, as best as can be understood by the Examiner, it appears that Jones is capable of storing and obtaining music information pertaining to music data. The Examiner maintains that Jones is functionally equivalent to the Applicant's invention since Jones performs the same function.

Allowable Subject Matter

It is difficult for the Examiner to clearly understand the claim language and therefore the indication of any allowable limitations should be regarded as merely provisional. However, if the Applicant is actually "substituting" data or "adding" data depending on contents of locally stored data, this may be allowable (i.e., if these limitations can be written clearly and cogently). Also, if by "version" the Applicant is referring to software version updates, then claims 1 and 8 may be allowable. Again, clearly written language is necessary.

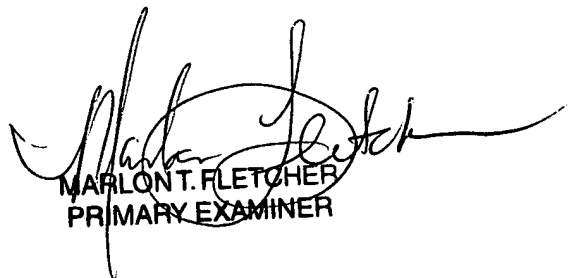
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The document to Csicsatka (2003/0158737) discloses Applicant's invention. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David S. Warren whose telephone number is 571-272-2076. The examiner can normally be reached on M-F, 9:30 A.M. to 6:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Bradley can be reached on 571-272-2001 ext 33. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

dsw



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PRIMARY EXAMINER